



**In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences**

In re Application of: ZURAWSKI
Serial No.: 09/658,238
Filed: September 8, 2000
Group No.: 2143
Confirmation No. 3002
Examiner: David E. England
Title: METHOD AND APPARATUS FOR
TRIGGERING AUTOMATED PROCESSING
OF DATA

Mail Stop: Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Dear Sir:

**CERTIFICATE OF MAILING
BY EXPRESS MAIL**

I hereby certify that this communication is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 on the date indicated below and is addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Willie Jiles

Willie Jiles

Date: May 9, 2005

Exp. Mail Receipt No. EV 322271604 US

Appeal Brief

Appellant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed November 5, 2004 ("Final Office Action"), finally rejecting Claims 1-17, all of which are pending in this case. Appellant filed a Notice of Appeal on February 7, 2005. Appellant respectfully submits this Appeal Brief with the statutory fee of \$500.00.

Table of Contents

Real Party In Interest	3
Related Appeals and Interferences	4
Status of Claims.....	5
Status of Amendments.....	6
Summary of Claimed Subject Matter	7
Grounds of Rejection to be Reviewed on Appeal	9
Argument	10
I. Appellant Stands Ready to File a Terminal Disclaimer if Necessary and Appropriate to Overcome the Double Patenting Rejection	10
II. The Drawings Show Every Feature of the Claims	10
“Predetermined Function Definitions”	10
“Function Portions”	11
“Trigger”	11
“Causing Said Data Source to Automatically Transmit Said Trigger Through a Communications Link”	12
“Responding to Receipt of Said Trigger Through Said Communications Link By Effecting Said Initiating of Execution of Said Project Definition”	13
III. The Specification Describes the Invention in Sufficient Detail to Enable One of Ordinary Skill in the Art to Make and Use the Invention - the Examiner’s Rejection Under 35 U.S.C. §112, First Paragraph is Improper	16
“Predetermined Function Definitions”	16
“A Plurality of Function Portions”	16
“Trigger”	17
IV. The Examiner’s Rejection of Claims 1-17 Under 35 U.S.C. § 103 Based on the <i>Coile-Hasegawa-Nguyen</i> Combination is Improper.	19
There is no suggestion or motivation in the cited references or in the prior art to combine <i>Coile</i> , <i>Hasegawa</i> , and <i>Nguyen</i>	19
The proposed <i>Coile-Hasegawa-Nguyen</i> combination fails to teach or suggest all elements of the claims	21
Conclusion	24
Appendix A: Claims on Appeal.....	25
Appendix B: Evidence.....	32
Appendix C: Related Proceedings.....	33

Real Party In Interest

The real party in interest for this Application under appeal is Corel Corporation of Ottawa, Ontario, Canada, as indicated by the Patent Assignment filed March 4, 2005.

Related Appeals and Interferences

An appeal filed for U.S. Patent Application Serial No. 09/658,016 may directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

Status of Claims

Claims 1-17 were rejected in the Final Office Action. Claims 1-17 are all presented for appeal and are set forth in Appendix A.

Status of Amendments

All amendments submitted by Appellant were entered by the Examiner before the issuance of the Final Office Action.

Summary of Claimed Subject Matter

The traditional approach for carrying out image processing involves manually adjusting images on an image-by-image basis using image processing software that requires extensive operator interaction. *Specification*, at p. 3, ll. 4-8. A less common approach includes hard-coding software routines in line-by-line source code. *Id.*, at ll. 12-14. One difficulty that arises using these techniques involves accurately predicting how images will appear after being subjected to a variety of processing operations. *Id.*, at p. 3, ln. 26-p. 4, ln. 2.

The present invention provides a method and apparatus for facilitating efficient and accurate preparation of a project definition which will control automated processing of data. *Id.*, at p. 5, ll. 2-7. A project definition defines how data obtained from files storing images will be processed. *Id.*, at p. 9, ll. 5-7. A project definition may recognize source modules, branch modules, action modules, and destination modules. *Id.*, at p. 15, ll. 3-12. These modules may define where to find data for processing, which data should be processed, what processing should be performed on the data, and where to put processed data. *Id.*, at ll. 15-21. For example, processing an image may include beveling, blurring, and/or tinting an image. *Id.*, at p. 28, ll. 1-16; p. 28, ll. 17-29; p. 36, ll. 27-34. Processing may also include adding an image and/or text to another image. *Id.*, at p. 36, ll. 16-26; p. 41, ll. 1-15. Project definitions may be visually represented. *Id.*, at p. 45, ll. 27-30; p. 92, ll. 13-21; Fig. 6-8. Modules included in a project definition may be visually represented, for example, using a rectangular box, icon, or other appropriate representation. *Id.*, at p. 44, ll. 15-26.

Various computer application programs may be used to create a project definition. *Id.*, at p. 87, ll. 5-19. For example, to prepare a project definition, a user may select desired modules for inclusion in the project definition by pointing and clicking in a viewable area of a screen using a mouse. *Id.*, at p. 91, ll. 13-19. Input ports and output ports of modules included in a project definition may be bound together to create binding definitions, for example, by using a mouse to create binding lines. *Id.*, at p. 92, ln. 22-p. 93, ln. 24.

To preview the effect of a module, a user may cause a sample image to be displayed showing the effects of parameter settings associated with the module. *Id.*, at p. 100, ll. 13-25. During creation or modification of the project definition, this preview function permits variable parameters associated with the module to be rapidly and accurately adjusted to an

appropriate setting, so that a satisfactory result will be achieved when that module is used during subsequent execution of the project definition. *Id.*, at p. 101, ll. 4-12.

The present claims provide for displaying of a project window that includes a graphical representation of the project definition. As an example of this operation, Figure 14 illustrates a graphical user interface displaying a project definition. The graphical interface can further permit user interaction with the project definition, for example, using a pointing device. The independent claims each include elements addressing this type of operation.

In addition, the project definition may be linked or otherwise associated with image data, such that changes of the image data can result in automatic execution of the project definition. The independent claims each include elements addressing this type of operation. This execution may occur, for example, in response to a data source generating a trigger and communicating the trigger through a communication link.

In a previous office action, the Examiner objected to the drawings and rejected certain claim elements under 35 U.S.C. §112, first paragraph. In response, Appellant previously presented a detailed response summarizing portions of the specification that describe particular examples of selected claim elements. The Examiner has maintained his positions, and thus the Argument section presents again the summaries for the selected claim elements. Rather than reiterate those summaries in this section, Appellant directs the Boards' attention to the summaries in Sections II and III of the Argument portion of this Appeal Brief for additional summary of the claimed subject matter.

Grounds of Rejection to be Reviewed on Appeal

Appellant requests that the Board review:

- I. The Examiner's rejection of Claims 1, 7, 11, and 16 under the judicially created doctrine of double patenting.
- II. The Examiner's objections to the drawings under 37 C.F.R. §1.83(a).
- III. The Examiner's rejection of Claims 1-3, 7-11, and 15-17 under 35 U.S.C. §112, first paragraph.
- IV. The Examiner's rejection of Claims 1-17 under 35 U.S.C. §103(a) as unpatentable over the combination of U.S. Patent No. 6,654,795, issued to Coile ("*Coile*"), U.S. Patent No. 6,333,752, issued to Hasegawa, et al. ("*Hasegawa*"), and U.S. Patent No. 6,202,070, issued to Nguyen, et al. ("*Nguyen*").

Argument

I. Appellant Stands Ready to File a Terminal Disclaimer if Necessary and Appropriate to Overcome the Double Patenting Rejection

The Examiner provisionally rejects Claims 1, 7, 11, and 16 under the judicially created doctrine of double patenting as being unpatentable over Claims 1 and 7 of copending U.S. Application No. 09/658,237. The Examiner also provisionally rejects Claims 1, 7, 11, and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 7 of U.S. Application No. 09/658,237 in view of U.S. Patent No. 6,202,070, which issued to Nguyen, et al. If necessary and appropriate, Appellant stands ready to file a terminal disclaimer to overcome any non-provisional double-patenting rejection.

II. The Drawings Show Every Feature of the Claims

The Examiner objects to the drawings under 37 C.F.R. §1.83(a). In particular, the Examiner contends that “predetermined function definitions,” “function portions,” “trigger,” “causing said data source to automatically transmit said trigger through a communications link,” and “responding to receipt of said trigger through said communications link by effecting said initiating of execution of said project definition” are not shown in the drawings. Appellant disagrees.

“Predetermined Function Definitions”

Memory 452 and standard definitions 461 of Figure 9 illustrate one example of “predetermined function definitions.” As discussed in the specification at lines 14-22 of page 83:

Stored within the memory 452 are a plurality of standard definitions 461, including all of the definitions set forth in TABLES 1-4. The standard definitions at 461 include not only the executable object code for each definition, but also a separate file which contains the corresponding source code. In the disclosed embodiments, the source code for each standard definition is expressed in a language known as VISUAL BASIC, which was developed by Microsoft Corporation of Redmond, Washington.

Thus, Appellant submits that the drawings, without correction, show at least one embodiment of "predetermined function definitions."

"Function Portions"

Branch module 26 and action modules 31 and 32 of Figure 1 illustrate one example of "function portions." As discussed in the specification at lines 3-21 of page 15:

The project definition 14 in FIGURE 1 is a simple example, but has been configured to show at least one example of each of the four types of modules that are recognized in the disclosed embodiments of the present invention. In other words, the disclosed embodiments of the present invention recognize source modules, one example of which appears at 21, branch modules, one example of which appears at 26, action modules, two examples of which appear at 31 and 32, and destination modules, two examples of which appear at 37 and 38. As reflected by the brackets along the bottom of FIGURE 1, branch modules and action modules are sometimes referred to collectively herein as function modules. Source modules deal with the question of where to find the data to be processed, branch modules deal with the question of which data should and should not be processed in a specified manner, action modules deal with the question of what processing should be performed on the data, and destination modules deal with the question of where to put the processed data.

Thus, Appellant submits that the drawings, without correction, show at least one embodiment of "function portions."

"Trigger"

Request queue 296 of Figure 9 illustrates one example of a "trigger." As discussed in the specification from line 30 of page 71 to line 24 of page 72:

The memory 278 also stores a request queue 296. Execution of one of the project definitions 286 is initiated in response to receipt by the process server 212 of a request. Such a request may arrive through the intranet 206 and/or Internet 208, for example from a user at one of the workstations 211 and 226. When the request arrives, the request is temporarily placed in the queue 296, which implements a first-in, first-out stack. Typically, the request will identify one of the project definitions stored at 286 in one of the sets of user data 281-284. Alternatively, however, the request may be accompanied by a project definition and any custom definitions used by that project definition, which are then temporarily stored in the user

data 281 for that user, until execution of that project definition has been completed.

Requests for the queue 296 may also originate in some other manner. For example, assume that a given project definition stored in one of the portions 286 of the memory 278 processes data from the database 227. The database 227 may include a script or other intelligence which, in response to a change to the pertinent source data in the database 227, automatically generates and sends to the process server 212 a request for execution of the given project definition, so that the modified data will be automatically processed. According to a feature of the invention, each request sent from any source to the process server 212 is expressed in a public communication protocol, which in the disclosed embodiments is the XML protocol.

Thus, Appellant submits that the drawings, without correction, show at least one embodiment of a “trigger.”

“Causing Said Data Source to Automatically Transmit Said Trigger Through a Communications Link”

Request queue 296 of Figure 9 further illustrates one example of “causing said data source to automatically transmit said trigger through a communications link.” As discussed in the specification from line 30 of page 71 to line 24 of page 72:

The memory 278 also stores a request queue 296. Execution of one of the project definitions 286 is initiated in response to receipt by the process server 212 of a request. Such a request may arrive through the intranet 206 and/or Internet 208, for example from a user at one of the workstations 211 and 226. When the request arrives, the request is temporarily placed in the queue 296, which implements a first-in, first-out stack. Typically, the request will identify one of the project definitions stored at 286 in one of the sets of user data 281-284. Alternatively, however, the request may be accompanied by a project definition and any custom definitions used by that project definition, which are then temporarily stored in the user data 281 for that user, until execution of that project definition has been completed.

Requests for the queue 296 may also originate in some other manner. For example, assume that a given project definition stored in one of the portions 286 of the memory 278 processes data from the database 227. The database 227 may include a script or other intelligence which, in response to a change to the pertinent source data in the database 227,

automatically generates and sends to the process server 212 a request for execution of the given project definition, so that the modified data will be automatically processed. According to a feature of the invention, each request sent from any source to the process server 212 is expressed in a public communication protocol, which in the disclosed embodiments is the XML protocol.

Thus, Appellant submits that the drawings, without correction, show at least one embodiment of "causing said data source to automatically transmit said trigger through a communications link."

"Responding to Receipt of Said Trigger Through Said Communications Link By Effecting Said Initiating of Execution of Said Project Definition"

Figure 11 illustrates one example of "responding to receipt of said trigger through said communications link by effecting said initiating of execution of said project definition."

As discussed in the specification from line 17 of page 74 to line 20 of page 77:

FIGURE 11 is a flowchart showing a portion of the operation of the load balancing module 309, and in particular deals with how tasks corresponding to the requests in the queue 296 are allocated among the imaging servers 221-223. At block 361, the processor 277 checks to see whether the queue 296 is empty. If it is empty, then the processor waits at block 361 until there is at least one request in the queue. Of course, the activity depicted in FIGURE 11 will typically be carried out on a time sliced basis, such that the processor 277 will be simultaneously executing other routines in parallel with the loop shown in FIGURE 11, including the routine shown in FIGURE 10.

When it is determined at block 261 that the queue 296 includes at least one request, then control proceeds from block 361 to block 362. In block 362, the processor 277 retrieves from the queue 296 the request which has been in the queue the longest. Then, at block 363, the load balancing module 309 in the processor 277 interacts with the imaging servers 221-223 through the watchdogs 306-308 and the intranet 206, in order to determine the extent to which each has available capacity for additional work. If none of them has any significant amount of available capacity, then at block 366 control is returned to block 363, in order to continue to evaluate availability of the processors in the imaging servers, until it is determined at block 366 that at least one of the imaging servers 221-223 has some available processing capability.

Control then proceeds from block 366 to block 367, where the load balancing module 309 evaluates the project definition 286 associated with the request which was retrieved from the queue at block 362. This evaluation may include inspection not only of the project definition itself, but also some of the data which is slated to be processed by that project definition. The evaluated characteristics may include the complexity of the project definition, and also the type and amount of data which that project definition is slated to process. For example, in the case of image data, the amount of image data depends on both the number of images and also the size of the images.

Control then proceeds to block 368, where the evaluations made in block 363 and 367 are used to determine whether it is possible to launch execution the project definition which is identified by the request drawn from the queue at 362. In this regard, there are several different ways in which a given project definition can be launched. First, if one of the imaging servers 221-223 has a level of availability which will permit it to take on execution of the project definition in question, execution of the project definition can be launched on that imaging server alone. However, if the project definition itself is relatively complex, and/or if there is a relatively large amount of data which it must process, two or more instances of the project definition may be launched, each configured to process a respective mutually exclusive portion of the specified data. A decision needs to be made as to whether to launch them on the same processor or on different processors.

In more detail, where it appears that two or more instances of the same project definition should be launched, the load balancing server must also factor in the available capacity of the imaging servers 221-223. Assuming that there is a satisfactory level of capacity in the imaging servers, each instance of the given project definition will typically be launched on a respective different one of the imaging servers 221-223. However, where one of the imaging servers 221-223 has significant capacity, it is possible that two or more instances of the same project definition could be launched on the same processor, if it appeared that the project definition and associated data were such that both instances could be efficiently processed at the same time. In this regard, and as noted above, there will be points in time when the execution of a project definition is temporarily idle, for example because it is waiting for data to arrive through a network, or because it includes an Interactive module (TABLE 2) and is waiting for a user response. When one instance of the project definition is idle, the other instance(s) can be active, as a result of which it is possible for a single processor to more quickly execute two

instances of the same project definition handling respective portion of the data than to execute a single instance handling all the data.

If it is determined at block 368 that there is an appropriate way to launch the project definition in question, control proceeds from block 368 to block 371, where the project definition is launched in the form of one or more instances on one or more imaging servers. Each such instance is launched by having the load balancing module 309 configure a task of the type shown at 251 or 252 (FIGURE 9), including the project definition at 256, and including at 257 any executables that correspond to any custom definitions which are used in that project definition. Control then proceeds from block 371 to block 372, where the load balancing module 309 provides to one or more of the watchdogs 306-308, as appropriate, information regarding the instance(s) of the project definition which have just been launched, and which the watchdog(s) will need to monitor. In this regard, the watchdogs 306-308 will already be running, but are initialized with information specific to the new project definition, so that each watchdog monitoring an imaging server that is executing an instance of the project definition will be fully aware of all project definitions that are being executed by that imaging server. From block 372, control returns to block 361, to handle the next successive request in the queue.

Thus, Appellant submits that the drawings, without correction, show at least one embodiment of “responding to receipt of said trigger through said communications link by effecting said initiating of execution of said project definition.”

Appellant presented the above descriptions in response to the Examiner’s initial objections to the drawings. In response, the Examiner notes that the drawings merely provide examples and appears to request that Appellant provide specific definitions for the limitations in the claims. Appellant respectfully submits that the claim terms should take their plain, ordinary meaning, given their context, as would be attributed by one of ordinary skill in the art.

Also, the Examiner’s implication that the drawings should disclose more than examples runs afoul of settled case law. The specification, including the drawings, need not be a production specification detailing every conceivable embodiment of the claimed invention. *See, e.g., Koito Mfg. Co. v. Turn-Key-Tech LLC*, 381 F.3d 1142, 1155-56 (Fed. Cir. 2004). Rather, providing specific embodiments contemplated by the inventors satisfies the requirements of § 112. *See, e.g., Cordis Corp. v. Medtronic, Inc.*, 339 F.3d 1352, 1365

(Fed. Cir. 2003) (a patentee is not required to describe in the specification every conceivable and possible future embodiment of his invention).

Because the drawings show at least one embodiment of all aspects of the claims, Appellant respectfully requests the Board to direct the Examiner to withdraw the objections to the drawings.

III. The Specification Describes the Invention in Sufficient Detail to Enable One of Ordinary Skill in the Art to Make and Use the Invention - the Examiner's Rejection Under 35 U.S.C. §112, First Paragraph is Improper

The Examiner rejects Claims 1-3, 7-11, and 15-17 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner contends that "predetermined function definitions," "a plurality of function portions," and "trigger" are not described in the specification in such a way as to enable one skilled in the art to make and use the invention. Appellant disagrees.

"Predetermined Function Definitions"

The specification describes predetermined function definitions in such a way as to enable one skilled in the art to make and use the invention and includes numerous descriptions of predetermined function definitions. For example, Tables 2 and 3, titled "Branching Definitions" and "Action Definitions" respectively, describe examples of predetermined function definitions at pages 23-41. Besides providing summaries of functions, these tables provide details such as names, ports, types, and descriptions of variables used by the functions. This description of predetermined function definitions would enable one skilled in the art to make and use at least one embodiment of the invention as claimed.

For at least these reasons, Appellant respectfully requests the Examiner to reconsider and withdraw the §112, first paragraph rejection of the Claims 1, 7, 11, and 16.

"A Plurality of Function Portions"

The specification includes numerous descriptions of function portions and thus describes a plurality of function portions in such a way as to enable one skilled in the art to make and use the invention. For example, at lines 19-26 of page 45, the specification

describes action modules 73 and 74 of Figure 6, which represent two examples of function portions:

The action module 73 is a Fill module, which adds color to an active object of the image, and then outputs at 78 the modified image data. The action module 74 is a Text Stamper module, which superimposes onto the image data received at 78 the text string received at 79. As noted above, this text string represents a price. The text will be added as a new and further object in the image data, which thereafter becomes the active object.

Furthermore, the discussions associated with Figures 8, 14, 15, and 16 further describe other examples of function portions. These descriptions of function portions would enable one skilled in the art to make and use at least one embodiment of the invention as claimed.

For at least these reasons, Appellant respectfully requests the Examiner to reconsider and withdraw the §112, first paragraph rejection of the Claims 1, 7, 11, and 16.

“Trigger”

The specification includes numerous descriptions of triggers and thus describes a trigger in such a way as to enable one skilled in the art to make and use the invention. For example, the specification, at lines 3-20 of page 101, summarizes ways to trigger the execution of a project definition:

The present invention provides a number of technical advantages. One such technical advantage results from the provision of the capability to trigger the execution of a project definition in various ways. One such capability is effective where an update is made to source data that is processed by the project definition, and involves automatic triggering of execution of the project definition. Another such capability is effective where execution of the project definition is triggered by receipt of a communication that is expressed in a public communication protocol, such as the eXtensible Markup Language (XML). These capabilities reduce or eliminate the need for human interaction to trigger execution of a project definition, and/or permit the execution of a project definition to be initiated from a remote location. Consequently, the functionality of project definitions according to the present invention is increased, while in many cases reducing or eliminating the possibility of human error.

The use of a communication to trigger execution of a project definition is discussed in other parts of the specification. For example, as discussed in the specification from line 30 of page 71 to line 24 of page 72:

The memory 278 also stores a request queue 296. Execution of one of the project definitions 286 is initiated in response to receipt by the process server 212 of a request. Such a request may arrive through the intranet 206 and/or Internet 208, for example from a user at one of the workstations 211 and 226. When the request arrives, the request is temporarily placed in the queue 296, which implements a first-in, first-out stack. Typically, the request will identify one of the project definitions stored at 286 in one of the sets of user data 281-284. Alternatively, however, the request may be accompanied by a project definition and any custom definitions used by that project definition, which are then temporarily stored in the user data 281 for that user, until execution of that project definition has been completed.

Requests for the queue 296 may also originate in some other manner. For example, assume that a given project definition stored in one of the portions 286 of the memory 278 processes data from the database 227. The database 227 may include a script or other intelligence which, in response to a change to the pertinent source data in the database 227, automatically generates and sends to the process server 212 a request for execution of the given project definition, so that the modified data will be automatically processed. According to a feature of the invention, each request sent from any source to the process server 212 is expressed in a public communication protocol, which in the disclosed embodiments is the XML protocol.

These descriptions of a trigger would enable one skilled in the art to make and use at least one embodiment of the invention as claimed.

As above with respect to the objections to the drawings, Appellant presented the preceding descriptions in response to the Examiner's initial rejection under § 112, first paragraph. In response, the Examiner again notes that the drawings and referenced portions of the specification merely provide examples, and the Examiner again requests specific definitions for the limitations in the claims. Again, Appellant respectfully submits that the claim terms should take their plain, ordinary meaning, given their context in the claim language and the descriptions in the specification, as would be attributed by one of ordinary skill in the art.

Moreover, as discussed above, the specification provides specific embodiments contemplated by the inventors and fully satisfies the requirements of § 112. Appellant thus respectfully requests the Board to direct the Examiner to withdraw the rejection under 35 U.S.C. § 112, first paragraph.

IV. The Examiner's Rejection of Claims 1-17 Under 35 U.S.C. § 103 Based on the *Coile-Hasegawa-Nguyen* Combination is Improper.

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation in the prior art to modify or combine the references, and the combination must teach or suggest all elements of the rejected claims. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The Examiner's rejection of Claims 1-17 under 35 U.S.C. § 103 fails both of these requirements. First, there is no suggestion or motivation in the cited references or in the prior art to combine *Coile*, *Hasegawa*, and *Nguyen*. Second, even if the combination were proper, the proposed *Coile-Hasegawa-Nguyen* combination fails to teach or suggest all elements of the claims.

There is no suggestion or motivation in the cited references or in the prior art to combine *Coile*, *Hasegawa*, and *Nguyen*.

The proposed combination of *Coile*, *Hasegawa*, and *Nguyen* is improper because the prior art fails to suggest or motivate the proposed combinations of the references. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

Nothing in *Coile*, *Hasegawa*, or *Nguyen* suggests or motivates the proposed combination. *Coile* provides "a system and method supporting efficient distribution of file access requests across one or more storage device systems." *Coile*, Abstract. *Hasegawa* provides an image processing apparatus that permits a user to view the effect of different combinations of parameters on a number of "peripheral" images related to a reference image. *See Hasegawa*, Col. 2, line 62 – Col. 3, line 8; Figure 9. *Nguyen* "discloses a system of software distribution in computer manufacturing which manages and distributes software

from release by a software engineering group to installation at a remote manufacturing site or testing facility.” *Nguyen*, Abstract.

These disparate fields of endeavor highlight the dramatic differences between the teachings of each reference. The U.S. classifications and fields of search emphasize these differences. None of the three references have common U.S. classifications with each other. *Coile* is classified in 709: “ELECTRICAL COMPUTERS AND DIGITAL PROCESSING SYSTEMS: MULTICOMPUTER DATA TRANSFERRING;” *Hasegawa* in 345: “COMPUTER GRAPHICS PROCESSING AND SELECTIVE VISUAL DISPLAY SYSTEMS;” and *Nguyen* in 707: “DATA PROCESSING: DATABASE AND FILE MANAGEMENT OR DATA STRUCTURES.”

Further, while *Coile* and *Nguyen* have minor overlap with respect to the indicated fields of search, *Hasegawa* shares no overlapping fields of search with either *Coile* or *Nguyen*. In fact, the references for *Hasegawa*’s fields of search are contained in a completely different search room at the Patent Office than for the other two references. Thus someone searching for references related to *Hasegawa* would be hard pressed to come across *Coile* or *Nguyen*, and even more hard pressed to find a motivation to combine the references.

Based on the differences between the references, one might expect the Examiner to provide sound reasoning as to why a person of skill in the art would have been motivated to make the combination. Surprisingly, the Examiner provides only conclusory statements that fail to demonstrate any suggestion or motivation to combine the references. For example, with regard to Claim 1, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hasegawa with Coile because it would allow the user to easily check the characteristics of each image, and quickly grasp situations such as separated shape and size of the image on the contracted image, therefore the user can efficiently retrieve and manipulate any image.

Final Office Action, at pp. 9-10 (sic). Similarly, with regard to Claim 2, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Hasegawa and Nguyen with Coile because of similar reasons as stated above and furthermore, it would make a system more efficient to have a real time system that transmits changes over a network automatically immediately as they happen.

Final Office Action, at p. 11 (sic). And with regard to Claim 3, the Examiner states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Nguyen with the combine system of Coile and Hasegawa because it would be more efficient for a system to be able to adapt and utilize a network that could communicate and interact with user around the world.

Final Office Action, at p. 12 (sic). These conclusory statements fail to show that the prior art suggests or motivates the proposed combinations of the references.

Appellant submits that there is no motivation for the proposed combination in the cited references or the prior art, and the Examiner's failure to point out any such motivation simply reflects this deficiency. At a minimum, the objective evidence of record fails to support the combination. The proposed combination of *Coile*, *Hasegawa*, and *Nguyen* is thus improper. For at least this reason, Appellant requests the Board to reverse the §103 rejection of Claims 1-17.

The proposed *Coile-Hasegawa-Nguyen* combination fails to teach or suggest all elements of the claims.

Appellant respectfully submits that, even if the proposed combination is given, *Coile*, *Hasegawa*, and *Nguyen* fail to teach or suggest every element of the claims. Consider Appellant's independent Claim 1, which recites:

A method, comprising the steps of:
providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for manipulating image data;
storing a project definition that is operable when executed to process said image data and includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;
displaying a project window that includes a graphical representation of said project definition;

allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

automatically initiating execution of said project definition in response to a change to said image data in said data source;

wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

Among other aspects of Claim 1, the *Coile-Hasegawa-Nguyen* combination fails to teach or suggest “displaying a project window that includes a graphical representation of said project definition,” or “allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool.” The Examiner fails to address the first of these two elements, and for the second of these two elements, the Examiner cites to *Hasegawa*. *Final Office Action*, at p. 10.

Consider that the claimed “project definition” includes multiple function portions each corresponding to a function definition, and that the project definition is operable when executed to process image data. While *Hasegawa* illustrates a graphical interface, this interface merely displays multiple versions of an image to permit a user to view the effect of different combinations of parameters on peripheral images related to a reference image. *See Hasegawa*, Col. 2, line 62 – Col. 3, line 8; Figure 9. The disclosure of *Hasegawa* fails to teach or suggest the claimed project definition, let alone the displayed project window that includes a graphical representation of the project definition and that allows user interaction with the project definition.

Moreover, Neither *Coile* nor *Nguyen* deal with the processing of image data. Thus neither of these references teach or suggest the claimed project definition. Also, neither of these references teach or suggest the displayed project window that includes a graphical representation of the project definition and that allows user interaction with the project definition.

Also, the *Coile-Hasegawa-Nguyen* combination fails to teach or suggest “automatically initiating execution of said project definition in response to a change to said image data in said data source.” As teaching this element, the Examiner points to a discussion in *Nguyen* of automatic database triggers. *Final Office Action*, at p. 10. The cited

portion of *Nguyen* discusses generic database triggers, such as an automatic notification letter sent upon the change of an address. *Nguyen*, col. 4, ll. 5-13. Generic database triggers, however, fail to teach or suggest the specific operation set forth in the claim.

Moreover, the cited portion of *Nguyen* deals with deficiencies of the prior art. Specifically, the cited portion deals with the problem of overhead, stating: “While convenient, [database triggers] can also increase the overhead consumed by a DBMS.” *Nguyen*, col. 4, ll. 12-13. *Nguyen* continues by stating that the invention of *Nguyen* seeks to overcome such deficiencies. *Nguyen*, col. 4, ll. 26-33. When one reference identifies operations that are undesirable, one of skill in the art would not be motivated to combine those teachings with other references. Rather, when one reference discourages particular operations, as *Nguyen* does here, that reference teaches away from a combination. *See, e.g., In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

As backup for the disclosure of *Nguyen*, the Examiner asserts that “broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.” *Final Office Action*, at p. 10. However, “automatically initiating execution of said project definition in response to a change to said image data in said data source,” as recited in Claim 1 in combination with a number of other elements, is not simply replacing manual activity. Rather, this element requires a particular type of operation that works in conjunction with other elements of the claims, and the Examiner has not shown any previous manual operations that would achieve all of the claimed aspects. Therefore, Claim 1 does not simply propose the automation of a previously manual process.

For at least these reasons, the proposed *Coile-Hasegawa-Nguyen* combination fails to teach or suggest all elements of Claim 1. For analogous reasons, the *Coile-Hasegawa-Nguyen* combination fails to teach or suggest aspects of independent Claims 7, 11, and 16. Claims 2-6, 8-10, 12-15, and 17 depend from Claims 1, 7, 11, and 16, respectively. Therefore, Appellant respectfully requests the Board to reverse the Examiner’s rejections and instruct the Examiner to issue a notice of allowance of Claims 1-17.

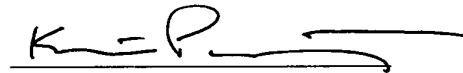
Conclusion

Appellant has demonstrated that the present invention, as claimed, is distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board to reverse the final rejection and instruct the Examiner to issue a notice of allowance of all claims.

Appellant has enclosed a check in the amount of \$500.00 for this Appeal Brief. Appellant believes no additional fees are due. The Commissioner is hereby authorized to charge any fee and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellant



Kurt M. Pankratz
Registration No. 46,977

Date: May 9, 2005

Customer Number **05073**

Appendix A: Claims on Appeal

1. (Previously presented) A method, comprising the steps of:

providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for manipulating image data;

storing a project definition that is operable when executed to process said image data and includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

displaying a project window that includes a graphical representation of said project definition;

allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

automatically initiating execution of said project definition in response to a change to said image data in said data source;

wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

2. (Previously presented) A method according to Claim 1, including the steps of:

causing said data source to automatically generate a trigger in response to a change to said image data therein;

causing said data source to automatically transmit said trigger through a communications link; and

responding to receipt of said trigger through said communications link by effecting said initiating of execution of said project definition.

3. (Original) A method according to Claim 2, including the step of expressing said trigger in a public communication protocol.

4. (Original) A method according to Claim 3, including the step selecting as said public communication protocol the eXtensible Markup Language (XML) protocol.

5. (Original) A method according to Claim 2, including the step of configuring said communications link to include a network.

6. (Original) A method according to Claim 5, including the step of configuring said network to include a portion of the Internet.

7. (Previously presented) A computer-readable medium encoded with a computer program which recognizes a set of predetermined function definitions that are different, at least one of said predetermined function definitions defining a function for manipulating image data, said program being operable when executed to facilitate:

storing of a project definition that is operable when executed to process said image data and includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

displaying of a project window that includes a graphical representation of said project definition;

allowance of a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

automatic initiation of execution of said project definition in response to a change to said image data in said data source;

wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

8. (Currently amended) A computer-readable medium according to Claim 7, wherein said program is operable when executed to effect said automatic initiation of execution in response to receipt through a communications link of a trigger automatically generated and transmitted by said data source in response to a change to said image data therein.

9. (Original) A computer-readable medium according to Claim 8, wherein said trigger is expressed in a public communication protocol, and wherein said program is operable when executed to accept said trigger in said public communication protocol.

10. (Original) A computer-readable medium according to Claim 9, wherein the public communication protocol in which said trigger is expressed is the eXtensible Markup Language (XML) protocol, and wherein said program is operable when executed to accept said trigger in said eXtensible Markup Language protocol.

11. (Previously presented) A method, comprising the steps of:

providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for manipulating image data;

storing a project definition that is operable when executed to process said image data and includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

displaying a project window that includes a graphical representation of said project definition;

allowing a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

automatically initiating execution of said project definition in response to receipt through a communications link of a trigger expressed in a public communication protocol;

wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

12. (Original) A method according to Claim 11, including the step of selecting as said public communication protocol the eXtensible Markup Language (XML) protocol.

13. (Original) A method according to Claim 11, including the step of configuring said communications link to include a network.

14. (Original) A method according to Claim 13, including the step of configuring said network to include a portion of the Internet.

15. (Original) A method according to Claim 13, including the step of causing a network browser program to respond to a manual input event by effecting the transmission of said trigger through said communications link.

16. (Previously presented) A computer-readable medium encoded with a computer program which recognizes a set of predetermined function definitions that are different, at least one of said predetermined function definitions defining a function for manipulating image data, said program being operable when executed to facilitate:

storing of a project definition that is operable when executed to process said image data and includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;

displaying of a project window that includes a graphical representation of said project definition;

allowance of a user to modify said project definition by interacting with said graphical representation using a pointing tool; and

automatic initiation of execution of said project definition in response to receipt through a communications link of a trigger expressed in a public communication protocol;

wherein said execution of said project definition operates at least in part to manipulate a graphical aspect of said image data.

17. (Original) A computer-readable medium according to Claim 16, wherein the said public communication protocol in which the trigger is expressed is the eXtensible Markup Language (XML) protocol, and wherein said program is operable when executed to accept said trigger in said eXtensible Markup Language protocol.

ATTORNEY DOCKET:
073030.0136

PATENT APPLICATION
09/658,238

32

Appendix B: Evidence

NONE

ATTORNEY DOCKET:
073030.0136

PATENT APPLICATION
09/658,238

33

Appendix C: Related Proceedings

NONE